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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,712	12/13/1999	NORIKO YURINO	07898/053001	1549

7590 11/03/2003

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

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DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/459,712

Applicant(s)

YURINO ET AL.

Examin r

Ardin Marschel

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-20,22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-20,22 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 27.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1631

**DETAILED ACTION**

Applicants' arguments, filed 7/22/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

**VAGUENESS AND INDEFINITENESS**

Claims 10-20, 22, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, line 2, has been amended to now cite the phrase "a type of biopolymers". This causes the claim to be vague and indefinite because the phrase "a type" is reasonably interpreted as being a singular type and not a plurality of types. The word "biopolymers" is plural and conflicts in the phrase "a type of biopolymers" with the singular phrase "a type". Is a singular type of biopolymer meant or a plurality of "biopolymers" due to the word "biopolymers"? Similarly, claim 24, lines 2-3, now contains the amended phrase "a type of sample nucleic acids" which also contains the above summarized conflict between the singular phrase "a type" and the plural word "acids" in the phrase "sample nucleic acids". Clarification of the meaning of the claims is requested via clearer claim wording. This rejection is necessitated by amendment. Claims which depend directly or indirectly from claims 16 or 24 are also rejected over

Art Unit: 1631

this issue due to their dependence thus also containing the above summarized unclarity.

In claim 24, third line of part (f), the phrase "dividing normalizing" is set forth. In the previous amendment, filed 11/20/02, in the claims section entitled "Version with markings to show changes made", the word "normalizing" was deleted apparently to clarify the awkward wording "dividing normalizing". The reinsertion of "normalizing" in the present form of claim 24, part (f), thus causes unclarity as to what is meant by whether dividing is meant or normalizing which optionally may be different practices. Clarification via clearer claim wording is requested. This rejection is necessitated by amendment due to the difference in claim wording from said previously submitted claim wording in said section entitled "Version...". Claims dependent directly or indirectly from claim 24 also contain this unclarity due to their dependence.

The unclarity in claim 16 regarding step (e) therein which cites detection of "hybridized" biopolymers remains in claim 16 as to whether the claim is meant to be limited to nucleobase hybridization practice or not. This conflict in practice specifically is present as to protein practice antecedent basis regarding biopolymer detection as in claim 22 which depends from claim 16. This basis for vagueness and indefiniteness of claims 16 and 22 is therefore maintained from the previous office action, mailed 3/24/03. It is noted that applicants have not argued or discussed this basis for rejection in the Remarks, filed 7/22/03.

The following basis for vagueness and indefiniteness of claim 16 and claims dependent therefrom is also maintained from the previous office action, mailed 3/24/03.

Art Unit: 1631

It is noted that applicants have not argued or discussed this basis for rejection in the Remarks, filed 7/22/03. Claims 10-15, 17-20, and 22 all depend directly or indirectly from claim 16 which contains the vagueness and indefiniteness of the confusing phrase therein given as "each different and separate predetermined and the" which seems to be lacking the word "position" after "predetermined". This lacking of the word "position" is different from the similar phrase in the last three lines of claim 16 which does contain the word "position" after "predetermined". Clarification via clearer claim wording is requested.

No claim is allowed.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Art Unit: 1631

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

October 30, 2003

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER